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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,244	03/09/2005	Ludwig Schieferstein	C 2714 PCT/US	2856

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COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

KHAN, AMINA S

ART UNIT	PAPER NUMBER
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1751

MAIL DATE	DELIVERY MODE
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09/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,244	Applicant(s) SCHIEFERSTEIN ET AL.	
	Examiner Amina Khan	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/11/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants arguments filed on July 11, 2007
2. Claims 14-33 are pending. Claims 1-13 have been cancelled.
3. Claims 14-26 and 29-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. et al. (US 3,256,230) for the reasons set forth in the previous office action.
4. Claims 27 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. et al. (US 3,256,230) in view of Maekawa (EP 1146103) for the reasons set forth in the previous office action.

Response to Arguments

5. Applicant's arguments filed regarding Johnson, Jr. et al. (US 3,256,230) and Maekawa (EP 1146103) have been fully considered but they are not persuasive.

The applicant argues:

"Copolymers of the (meth)acrylic acid perfluorinated alkyl alcohol with other ethylenically unsaturated monomers are shown in Table III to be ineffective as oil and water repellent-treating compositions. At col. 10, lines 12-15, Johnson Jr. et al. teaches: "The marked superiority of the polymer mixtures over the copolymers is apparent from Table

3, The copolymers shown in Table III are not improved by dilution with another non-fluorinated polymer."

In contrast to the teaching of Johnson Jr. et al., Applicants have discovered a narrow group of copolymers of a (meth)acrylic acid ester of a perfluorinated alkyl alcohol when mixed with a certain small group of copolymers of a certain composition as claimed in the present application, provides excellent water repellancy properties to the composition when applied to fibers. Applicants therefore respectfully submit that the present invention is unexpected in view of the teachings of Johnson Jr. et al.

Firstly, Johnson Jr. et al. teaches away from the present invention. In addition, Johnson Jr. et al. neither teaches nor suggests the particular mixture of copolymers, which Applicants have found to be effective hydrophobicizing compositions for fibers and textile materials. Since Johnson Jr. et al. teaches away from the present invention and neither teaches nor suggests the particularly narrow range of copolymers useful in the practice of the present invention. Applicants respectfully submit that Johnson Jr. et al. neither teaches nor suggests the present invention and a rejection based thereon is untenable."

The examiner asserts that Johnson Jr. et al. clearly teach an embodiment for their invention comprising a blend of copolymers wherein the first copolymer comprises monomers of a homolog of the instantly claimed formula (II) and monomers of formula (Ia) and a second copolymer comprises monomers of formula (I) and (II). Johnson Jr. et al. teach methods of applying dispersions of copolymers to textiles for the benefit of oil

and water repellence (column 2, lines 5-35). The showings of Table III are not commensurate in scope with the broad range of compounds and ratios of copolymers disclosed in the instant claims. Furthermore, "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (see MPEP 2145). Maekawa et al. is simply relied upon to show that the instantly claimed organic solvents are suitable dispersion agents for applying similar compositions to textiles for the benefits of oil and water repellence.

For this reason the rejections are maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AK

AK
September 20, 2007

Douglas McGinty
DOUGLAS MCGINTY
SUPERVISORY PATENT EXAMINER

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